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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,678	08/01/2001	Ralf Wichmann	LE 00/032 (7244*111)	6224

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 12/30/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/919,678	Applicant(s) WICHMANN ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November and 13 and 17 December 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30, 37 and 42-50 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 and 42-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37 and 47-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-30 and 42-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

This is in response to Papers filed on 18 November and 13 and 17 December 2002.

- I. Applicants elect the invention of claims 37 and 47-50 without traverse being acknowledged.
- II. Applicants urge that since the dependent claims 42-46 are depended on the independent claim 37, claims 42-46 should be rejoined with the claims if claim 37 would be found to be allowable. It has some merits. But claims 42-46 must be presented in a proper form, such as ---
The solution in claim 37 for use with a photographic material having...--- or ---A method of using the solution in claim 37 with a photographic material having...---.
- III. The record shows that the instantly elected invention of claims 37 and 47-50 is not patentably different or distinct from the of claims 1-9 in Price et al (6,365,332). It is also found that there is a sufficient reason with respect to a very close time wide between Price et al filing date on 07 September 2000 and the foreign priority date on 04 August 2002 of the instant application for Eastman Kodak Company to request an interference process any time before this application is issued to be patent or a reexamination and interference processes at the same time if the application was issued to be a patent. The Office would also continue to examine the elected invention of claim 37 and 47-50. An interference process will be set up when claims 37 and 47-50 are found to be overcome all of the found and applied prior art.

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IV. The rejections on the record are simplified with no new prior art is added as followed:

(A) Claims 37 and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuse et al (5,453,348). Rogers et al (5,389,501), Ueda et al (5,580,705), Inaba et al (5,885,757) and Mc Guckin et al (6,022,674) are cited as the cumulative references at the present time and may be re-applied when Kuse et al is overcome.

Kuse et al disclose, teach, demonstrate and reduce to practice with a solution comprising a sufficient amount ferric salt of propylenediaminetetraacetic acid as a silver halide photographic bleaching agent. Please see the whole disclosure of the applied reference, especially at "Bleaching solution" on col.103:48-56 and Experiments 1(3, 4, 5, 10 and 11 in Table 1 on cols.105 and 106. Any embodiment being not directly related to the "solution" is considered as an intended use and would have and is given no value in the above applied statute under 35 USC 102 (but are given a full value in a process or method claim only as required). Since Kuse et al disclose, teach, demonstrate and reduce to practice with the solution containing the requisite chemical ingredient and its amount, the above claims are found to be anticipated by Kuse et al.

B. Claims 37 and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamashita et al (5,635,341). Rogers et al (5,389,501), Ueda et al (5,580,705), Inaba et al (5,885,757) and Mc Guckin et al (6,022,674) are cited as the cumulative references at the present time and may be re-applied when Yamashita et al is overcome.

Yamashita et al disclose, teach, demonstrate and reduce to practice with a solution comprising a sufficient amount ferric salt of propylenediaminetetraacetic acid as a silver halide photographic bleaching agent. Please see the whole disclosure of the applied reference, especially at "Bleach-fixer" on col.25:44-49 and Experiments 1(1-5) in Table 3. Any

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embodiment being not directly related to the "solution" is considered as an intended use and would have and is given no value in the above applied statute under 35 USC 102 (but are given a full value in a process or method claim only as required). Since Yamashita et al disclose, teach, demonstrate and reduce to practice with the solution containing the requisite chemical ingredient and its amount, the above claims are found to be anticipated Yamashita et al.

C. Claims 37 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuse et al (5,580,705). Others on the record are cumulative references at the present time and may be re-applied when Kuse et al is overcome.

Kuse et al disclose, teach, and suggests a color reversal silver halide photographic (col.87:30-31) bleachable solution comprising a sufficient amount ferric salt of propylenediaminetetraacetic acid bleaching agent ("Bleach solution" on col.103:48-56, Experiments 1(3, 4, 5, 10 and 11). Since Yamashita et al disclose, teach and suggest the main and essential embodiments of the claims, they are found to be rendered prima facie obvious by Kuse et al. The instantly elected invention of the solution claims 37 and 47-50 either may contain or may not contain an ammonium ion. It is a matter of choice of one skilled in the art. In addition, a carefully studying of the instant application as originally filed unveils that there is no criticality of a patentability for the solution to either contain or not contain an ammonium ion. Applicants should show otherwise. In the absence of convincing evidence for the record as originally filed, the issue of the claimed solution being either containing or not containing an ammonium ion is given no patentable value. The showings in the instant application have been considered but have and are given a little or limited value for a patentability of the claims as broadly disclosed with respect to numbers of the chemical and their amount in each of the tested solutions. It would

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like to see a result of a test using about 0.045 mol/l and about 0.25 mol/l of a claimed beaching agent.

D. Yamashita et al at "Bleach-fixer" on col.25:44-49 and Experiments 1(1-5) are cited to show the known selection of a bleachable solution containing no ammonium ion in the art as applied in paragraph "B." above.

E. Claims 37 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita et al (5,635,341). Others on the record are cumulative references at the present time and may be re-applied when Yamashita et al is overcome.

Yamashita et al disclose, teach, and suggests a color reversal silver halide photographic (col.11:25) bleachable solution comprising a sufficient amount ferric salt of propylenediaminetetraacetic acid bleaching agent ("Bleach-fixer" containing no ammonium ion on col.25:44-49, Experiments 1(1-5). Since Yamashita et al disclose, teach and suggest the main and essential embodiments of the claims, they are found to be rendered prima facie obvious by Yamashita et al. The showings in the instant application have been considered but have and are given a little or limited value for a patentability of the claims as broadly disclosed with respected to numbers of the chemical and their amount in each of the tested solutions. It would like to see a result of a test using about 0.045 mol/l and about 0.25 mol/l of a claimed beaching agent.

V. Applicant's arguments filed 13 November 2002 have been fully considered but they are not persuasive.

Applicants urge that Kuse et al is related to a negative color but not color reversal. The intended use has no value in the applied 35 USC 102. The fact is that they same the same

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solution chemically. Applicants should show an evidence to the contrary. The claimed intended use would be given full value in a process claimed only. Applicants also recognize that Kuse et al disclose, teach and suggest the use of the bleachable solution with a color reversal photographic material but urge that there is no showing in any examples. An applicable teaching or suggestion is not limited to an example under 35 USC 103.

Applicants urge that Yamashita et al is related to a negative color but not color reversal. The intended use has no value in the applied 35 USC 102. The fact is that they same the same solution chemically. Applicants should show an evidence to the contrary. The claimed intended use would be given full value in a process claimed only. Applicants also recognize that Yamashita et al disclose, teach and suggest the use of the bleachable solution with a color reversal photographic material but urge that there is no showing in any examples. An applicable teaching or suggestion is not limited to an example under 35 USC 103.

VI. There is no new reference being added or applied in the above rejection. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
December 19, 2002

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le